LIBRARY
SUPREME COURT, U.S.

IN THE

# Supreme Court of the United States

OCTOBER TERM, 19~~47~~ 48

No. ~~582~~ 16

MANDEL BROTHERS, INC., A CORPORATION,
*Petitioner,*

*vs.*

JOHN H. WALLACE, JR.,
*Respondent.*

## BRIEF OF RESPONDENT IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI.

CHARLES J. MERRIAM,
BERNARD A. SCHROEDER,
*Counsel for Respondent.*

CHRITTON, SCHROEDER, MERRIAM & HOFGREN,
*Attorneys for Respondent.*

IN THE

# Supreme Court of the United States

OCTOBER TERM, 1947.

---

**No. 582.**

---

MANDEL BROTHERS, INC., A CORPORATION,
*Petitioner,*

*vs.*

JOHN H. WALLACE, JR.,
*Respondent.*

---

## BRIEF OF RESPONDENT IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI.

---

*To the Honorable Chief Justice and Associate Justices of the Supreme Court of the United States:*

## SUPPLEMENTAL STATEMENT OF THE MATTER INVOLVED.

---

While there is a conflict between the decision of the Second Circuit Court of Appeals and that of the Seventh Circuit Court of Appeals as to the validity of Wallace and Hand patent No. 2,236,387, the two decisions were upon fundamentally different records in respect to the question of long felt want.

No effort was made in the New York case to prove long felt want, whereas a showing was made and accepted in the Seventh Circuit case of the existence of a long felt want for a non-corrosive antiperspirant.

The statement, therefore, on page 5 of the Petitioner's brief that the Second and Seventh Courts of Appeal disagreed as to the existence of long felt want would not necessarily have been true if the same record had been before each court. Certainly the Seventh Circuit Court would have found no long felt want if it had had before it only the record presented to the Second Circuit Court. Likewise, we believe it equally clear that the Second Circuit Court of Appeals would have found long felt want if it had had the record before the Seventh Circuit Court.

It is conceded that the use of urea to overcome or neutralize acidity was long known. What the Court of Appeals for the Second Circuit overlooked was that thousands of other materials had the same ability. The difficulty was that an antiperspirant required acidity in order to function, and no one prior to Wallace and Hand had solved the dilemma presented by the necessity of overcoming the bad effects of acidity while retaining acidity and its good effects.

We therefore do not regard any of the alleged questions presented by Petitioner as being fairly involved in a review. One Court did hold the patent valid and the other Court held the patent invalid, on a different record.

Petitioner does not charge that the Second Circuit Court of Appeals would have held the patent invalid if it had had before it the record upon which the Seventh Circuit Court based its decision. In such circumstances we find no conflict which need be resolved in the Supreme Court.

Petitioner also charges a conflict between the decision

of the Seventh Circuit Court of Appeals and the decisions of this Court in *Dow Chemical Co.* v. *Halliburton Oil Well Cementing Co.*, 324 U. S. 320, and *Sinclair & Carrol Co.* v. *Interchemical Corp.*, 325 U. S. 327.

In both decisions of this Court, the patent was based upon the use of a chemical to perform a chemical objective which the chemical was known to be capable of performing.

In the present case, urea is added to the antiperspirant in order to perform two functions which were essentially antagonistic to each other, and only one of which was a known function of the chemical.

An antiperspirant is effective because of its acidity. There are, however, secondary effects of this acidity which are harmful. Particularly, the astringents used will attack clothing. They will also injure the skin of certain sensitive individuals.

It was well known that urea would overcome these secondary effects. This was true of countless other materials which also have the ability to neutralize acids.

The difficulty was that the other materials which neutralized acids also prevented the antiperspirant from working, since they neutralized the primary acidity as well as the secondary acidity.

There is even today, except for the Wallace and Hand patent, no chemical teaching which would indicate that urea and its analogues would solve this dilemma, and even the Wallace and Hand patent did not discover why urea would permit the antiperspirant to retain acidity and yet neutralize the after-effects.

As defendant's expert said (Rec. 75):

> "the peculiarities of urea are such that the literature is not certain what happens with many straight compounds, let alone those that go into reversal."

It is believed that there is no necessary conflict between the decisions of the Second Circuit Court of Appeals and the Seventh Circuit Court of Appeals, in view of the differences in the records. There is no conflict between the decisions of this Court and that of the Seventh Circuit Court of Appeals.

Respectfully submitted,

CHARLES J. MERRIAM,
BERNARD A. SCHROEDER,
*Counsel for Respondent.*

February 28, 1948.

CHRITTON, SCHROEDER, MERRIAM & HOFGREN,
141 W. Jackson Blvd.,
Chicago, Illinois,
*Attorneys for Respondent.*